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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/019,387	03/26/2003	Maurizio Dalle Carbonare	2039-0156P	6340
2292	7590	04/06/2006	EXAMINER	
BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747			VANIK, DAVID L	
			ART UNIT	PAPER NUMBER
			1615	
DATE MAILED: 04/06/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/019,387

Applicant(s)

DALLE CARBONARE ET AL.

Examiner

David L. Vanik

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>12/28/2001</u> . | 6) <input type="checkbox"/> Other: ____ |

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DETAILED ACTION

Receipt is acknowledged of the Applicant's Information Disclosure Statement filed on 12/28/2001.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-12 are rejected under 35 U.S.C. 102(b) as being anticipated by WO 99/04828 ('828).

'828 disclose compositions comprising hyaluronic acid derivatives and methods of using said hyaluronic acid-based compositions to treat the formation of post-surgical adhesion and scar formation (abstract and page 51). Like the instant application, '828 discloses that the following set of hyaluronic acid derivatives can be used to treat adhesion and scar formation: (1) hyaluronic acid derivatives esterified with alcohols; (2) autocrosslinked esters of hyaluronic acid; (3) crosslinked hyaluronic acid compounds; (4) hemiesters of succinic acid; (5) N sulphated derivatives of hyaluronic acid; and (6) amide derivatives of hyaluronic acid (See page 4, lines 1-28). The above hyaluronic acid derivatives can be

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formulated as gels and additional pharmacologically active substances, such as antibiotics, may also be used the method (Claims 1-33).

The claims are therefore anticipated by WO 99/04828 ('828).

Claims 1-8, 12-13 are rejected under 35 U.S.C. 102(b) as being anticipated by WO 97/07833 ('833).

'833 disclose hyaluronic acid derivatives capable of being used for post-surgical adhesion (abstract). As set forth in '833, an "adhesion" is a permanent scar that connects two adjacent surfaces (page 2, lines 1-10). Like the instant application, '828 discloses that the following set of hyaluronic acid derivatives can be used to treat adhesion and scar formation: (1) hyaluronic acid derivatives esterified with alcohols; (2) autocrosslinked esters of hyaluronic acid; and (3) crosslinked hyaluronic acid compounds (page 9, lines 1-12; page 12, Example 3; page 14, lines 1-35; page 30, lines 29-35 and page 31, lines 1-25). The above hyaluronic acid derivatives can be formulated as gels and additional pharmacologically active substances, such as heparin, may also be used the method (Claims 1, 10 and page 31, Table 1).

The claims are therefore anticipated by WO 97/07833 ('833).

The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure. US Patents 5,676, 964 ('964) and US 4,851,521 are cited

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as patents of interest in their disclosure of the use of hyaluronic acid derivatives in treating scar formation


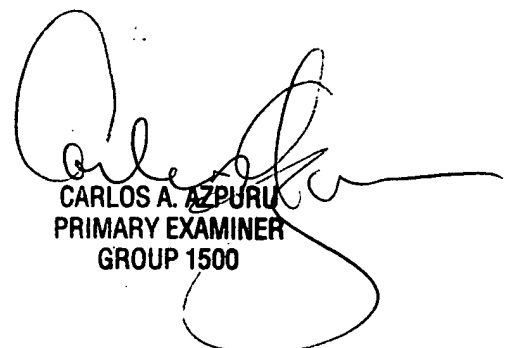
Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David L. Vanik whose telephone number is (571) 272-3104. The examiner can normally be reached on Monday-Friday 8:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman Page can be reached on (571) 272-0602. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

David Vanik, Ph.D.
Art Unit 1615


3/29/06
CARLOS A. AZPURU
PRIMARY EXAMINER
GROUP 1500